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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,764	01/16/2004	Akira Yamaguchi	09792909-5771	6420
26263 7590 04/27/2009 SONNENSCHN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				
EXAMINER				
RUTHKOSKY, MARK				
ART UNIT		PAPER NUMBER		
1795				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/758,764

Applicant(s)

YAMAGUCHI ET AL.

Examiner

Mark Ruthkosky

Art Unit

1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/2009 has been entered.

Claim Rejections - 35 USC § 112

The rejection of claims 1-7 and 16-19 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been overcome by applicant's amendment to the claims.

New Rejections- 35 USC § 112

Claims 1-7 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The amended claim limitation, "containing a gas absorbing carbon material within the battery for adsorbing carbon gas" is not clear since carbon is not a gas and the disclosure does not disclose a carbon gas. Clarification is required.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 and 16-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amended claim limitation, "containing a gas absorbing carbon material within the battery for adsorbing carbon gas" is new matter because the carbon material is not disclosed in the original specification to adsorb carbon gas. Clarification is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsufumi et al. (JP 09-035,718), in view of Takeuchi et al. (US 5,807,645) OR over Takeuchi et al. (US 5,807,645) in view of Mitsufumi et al. (JP 09-035,718.)

Mitsufumi et al. (JP 09-035,718) teaches a non-aqueous electrolyte battery comprising an anode having an anode mixture containing an anode active material, and a cathode having a cathode mixture containing a cathode active material, said anode and the cathode being layered

together via a separator (see paragraphs 2-33, figure 1 and the corresponding text); a solid electrolyte including a polymer material and an electrolyte salt contained therein (p. 28-29 and 35); and a film-shaped exterior material housing therein said battery device and the solid electrolyte (see figure 1 and p. 30 and 40); wherein a gas adsorbing carbon material formed of a carbonaceous material having a specific surface not less than $30 \text{ m}^2/\text{g}$, said gas adsorbing carbon material being added to said anode mixture and/or said cathode mixture for adsorbing a gas evolved within the battery (abstract, p. 23-26.) Carbon black is activated carbon as it absorbs gasses and is noted in an amount of 0.1-4% in the anode (p. 23-26.) Ketchien black and furnace black are taught in paragraph 25. Ketchien black and Ketjen black are the same material as noted above. The carbon material is taught to have a specific surface area of not less than $700 \text{ m}^2/\text{g}$.

Mitsufumi et al. (JP 09-035,718) does not teach the battery having a lithium anode, a high surface area carbon added to the cathode mixture in an amount of 0.2-8 wt. %, or a gel electrolyte comprising a non-aqueous electrolyte solvent.

Takeuchi et al. (US 5,807,645) teaches a battery comprising a lithium alloy anode, a positive electrode comprising acetylene black or carbon black having a surface area of not less than $30 \text{ m}^2/\text{g}$ (claim 20) in a range of 1-10 and 2-8 wt. % (see example 1, col. 9, claims 7-8 and 22-23.) Ketchien black and other carbon black materials are taught in cols. 7-9. Further, the battery includes a solid electrolyte comprising a lithium salt in a non-aqueous electrolyte solvent that is added to a polymeric separator (col. 5, line 7 to col. 6, line 15.) The polymer material holding the electrolyte includes non-woven fabrics of polyolefinic fibers including polyvinylidene fluoride, polytetrafluoroethylene and others (col. 5, lines 7-30.) Polyvinylidene

fluoride is noted in the instant specification as a high molecular weight material and will inherently have a molecular weight of 300,000 or more. Laminated and superposed fabrics including these materials are noted. Electrolyte salts of lithium hexafluorophosphate and borofluoride are taught in col. 6, lines 5-15. The electrolyte salt is mixed with a solvent, such as a carbonate and added to the polymer membrane (paragraph bridging cols. 5-6.) The addition of the carbon material reduces battery swelling from gas formation (col. 9.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include a high surface area carbon material in the cathode of Mitsufumi et al. (JP 09-035,718) OR to include a high surface area carbon in the anode of Takeuchi et al. (US 5,807,645), as both references teach that adding high surface area carbon diminishes cell swelling, suppresses an increase in internal pressure, and improves the charge transfer capability of the batteries (as taught in the references.) Further, lithium anodes are taught in alkali batteries to generate electrons and power the battery. One skilled in the art would use the anode materials taught in the prior art as the anode in an alkali batteries of record. Based on the teachings of the references, one skilled in the art would be motivated to use more than one type of active carbon because each carbon material noted is taught to absorb gasses and conduct electrons in the electrode mixture. The high surface area carbon materials are taught to absorb gasses within the volume of the structure. In addition, using an electrolyte having a non-aqueous solvent would have been obvious to one of ordinary skill in the art at the time of the invention based on the electrolyte materials used in the battery (see Takeuchi, paragraphs bridging cols. 5-6.) One of ordinary skill would recognize that aqueous solvents would be used in alkaline hydroxide cells and the non-aqueous solvent electrolytes will be used in lithium ion batteries. One skilled in the

art would be motivated to use a non-aqueous solvent with electrodes that destructively react with water, such as lithium based anodes.

With regard to the limitation that the battery comprises a gas adsorbing carbon layer containing a gas adsorbing carbon material within the battery for adsorbing carbon gas, the references each teach a gas absorbing carbon, as noted. The layers are the electrodes as the electrodes are layers, are within the battery and contain a gas absorbing carbon material. The recitation “for adsorbing carbon gas” is an intended use; however, as the materials of the reference are the same as those taught in the instant disclosure, the layer will inherently adsorb carbon gas.

The artisan would have found the claimed invention to be obvious in light of the teachings of the references.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsufumi et al. (JP 09-035,718) in view of Takeuchi et al. (US 5,807,645) OR over Takeuchi et al. (US 5,807,645) in view of Mitsufumi et al. (JP 09-035,718) as applied above, in view of Bannai (US 6,503,656 and EP 1,063,713.)

Mitsufumi et al. (JP 09-035,718) and Takeuchi et al. (US 5,807,645) teach non-aqueous electrolyte batteries, as noted. The battery may be housed in a cylindrical or square shaped housing. The references do not teach the battery to have a laminate film of a metal layer and a resin layer as an exterior casing material. Bannai et al. (EP 1,063,713) teaches a battery to have a laminate film of a metal layer and a resin layer as an exterior casing material (see the claims, p. 21-22.) It would have been obvious to one of ordinary skill in the art at the time the invention

was made to house the batteries of Mitsufumi and Takeuchi in a casing of a laminate film having a metal layer and a resin layer in order to provide a durable, light-weight casing that has low permeability due to the metal layer and high sealability due to the resin layer (see ¶713, p. 2-4.) The artesian would have found the claimed invention to be obvious in light of the teachings of the references.

Response to Arguments

Applicant's arguments filed 1/12/2009 with regard to the amended claims have been fully considered but are moot in view of the new rejections based on the amended claims. Further, the arguments based on the art applied are not persuasive.

Applicant argues that, "Mitsufumi et al. teaches the use of a carbonaceous material as a conducting material. Mitsufumi et al., Paragraphs [0023]; [0024]. However, Mitsufumi et al. does not specifically teach a gas adsorbing carbon layer containing a gas adsorbing carbon material within the battery for adsorbing carbon gas as required by the claims. Additionally, Mitsufumi et al. fails to teach or even fairly suggest a solid electrolyte that includes a fluorine-based high molecular weight material."

These arguments are not persuasive. Mitsufumi et al. teaches a gas adsorbing carbon layer containing a gas adsorbing carbon material within the battery, as noted in the rejection. The claimed layers are the electrodes of the batteries. The electrodes are layers, are within the battery and contain a gas adsorbing carbon material. As the materials of the reference are the same as those taught in the instant disclosure, the layer will inherently adsorb carbon gases. The prior art is not required to state that the carbon material is used for adsorbing carbon gas as

required by the claims. The claim is a product claim and the prior art teaching of a gas adsorbing carbon layer containing a gas adsorbing carbon material meets the required claim limitations.

As acknowledged in the rejection, Mistufumi et al. does not teach a solid electrolyte that includes a fluorine-based high molecular weight material. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Takeuchi et al. (US 5,807,645) teaches a battery comprising a lithium alloy anode, a positive electrode and a non-aqueous electrolyte added to a polyvinylidene fluoride polymer (col. 5, line 7 to col. 6, line 15.) The polymer material holding the electrolyte includes non-woven fabrics of polyolefinic fibers including polyvinylidene fluoride, polytetrafluoroethylene and others (col. 5, lines 7-30.) Polyvinylidene fluoride is noted in the instant specification as a high molecular weight material and will inherently have a molecular weight of 300,000 or more. The electrolyte salt is mixed with a solvent, such as a carbonate and added to the polymer membrane (paragraph bridging cols. 5-6.)

Applicant argues that, "Takeuchi et al. does not teach or even fairly suggest a gas adsorbing carbon layer as required by the claims. Furthermore, Takeuchi et al. does not teach a solid electrolyte that includes a fluorine-based high molecular weight material."

This argument is not persuasive. Takeuchi et al. does teach a gas adsorbing carbon layer as required by the claims. The layers are the electrodes, which are within the battery and contain a gas adsorbing carbon material. As the materials of the reference are the same as those taught in the instant disclosure, the layer will inherently adsorb carbon gas. Takeuchi et al. (US

5,807,645) teaches a polyvinylidene fluoride polymer material holding the electrolyte. Polyvinylidene fluoride is noted in the instant specification as a high molecular weight material and will inherently have a molecular weight of 300,000 or more. The electrolyte salt is mixed with a solvent, such as a carbonate and added to the polymer membrane forming the electrolyte (paragraph bridging cols. 5-6.) The addition of the carbon material reduces battery swelling from gas formation (col. 9.)

Applicant further argues that Bannai et al. does not cure the alleged deficiencies of Mistufumi and Takeuchi. The arguments with regard to Mistufumi and Takeuchi arguments have been previously addressed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references include general teachings and relevant features as to the state of the art at the time of the invention.

Examiner Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Ruthkosky whose telephone number is 571-272-1291. The examiner can normally be reached on FLEX schedule (generally, Monday-Thursday from 9:00-6:30.) If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free.)

/Mark Ruthkosky/

Primary Examiner, Art Unit 1795